

REMARKS

The Examiner is thanked for the thorough examination of the present application. The Office Action, however, tentatively rejected all claims 1-14. Applicant respectfully requests reconsideration of the rejections in view of the amendments and remarks made herein. Specifically, claim 1 is amended by incorporating subject matter from claim 2.

The Office Action rejected claim 12 under 35 U.S.C. § 112, first paragraph, stating that the specification does not teach how a peripheral device can integrate a printer and a mouse together. Applicant has amended claim 12 to correct this deficiency.

The Office Action also rejected claims 1-14 under 35 U.S.C. § 112, second paragraph, alleging that the specification does not define “a USB slot.” Applicant respectfully disagrees. In this regard, the specification is properly interpreted from the perspective of a person skilled in the art. Such a person would interpret a USB slot as a female receptacle (or port) for receiving a male connector of a USB connection. In support of this allegation, the undersigned performed an Internet search, using the “Google” search engine. Attached to this response is the results of this search. As can be seen, the very first item identified in the search references a “USB slot” in the context of a receiving slot for a flash memory. As the term “USB slot” is used as a staple term in the computer industry, the undersigned submits that the term need not be separately defined in the specification, as it will be readily understood by persons skilled in the art. Accordingly, the undersigned submits that the rejections under 35 U.S.C. § 112, second paragraph be withdrawn.

Claims 1-12 and 14 stand rejected under 35 U.S.C. 102(b) as allegedly anticipated by U.S. Patent 6,669,513 to Huang. Applicant has amended independent claim 1 to define, among other limitations, “a first peripheral device disposed in the housing, detachably connected to one of the universal serial bus.” No such feature is disclosed or suggested in Huang.

Instead, Huang discloses a USB hub and power adapter assembly comprising a power adapter main unit 1 and connection boxes 2 (21, 22, 23, 24, 25). The connection boxes 2 connect to USB output connector 161 of the power adapter main unit 1 from the exterior of the main unit 1. Importantly, Huang fails to teach that the first peripheral device is disposed in the housing, detachably connected to the USB. For at least this reason, claim 1 patently defines over the cited art.

As amended claim 1 has overcome the rejection, all remaining claims, which depend from claim 1, define over the cited art as well.

Claim 13 was rejected under 35 U.S.C. 103(a) as allegedly unpatentable over U.S. Patent 6,669,513 to Huang in further view of U.S. Patent 6,549,966 to Dickens et al. Since amended claim 1 has overcome the rejection, the rejection of dependant claim 13 should be withdrawn.

As a separate and independent basis for the patentability of claim 13, Applicant respectfully traverses the rejections as failing to identify a proper basis for combining the cited references. In combining these references, the Office Action stated only that the combination would have been obvious “in order to allow sharing of expensive peripherals between multiple devices.” (Office Action, page 5). This alleged motivation is clearly improper in view of well-established Federal Circuit precedent.

It is well-settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(Emphasis added.) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, Applicant notes that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. Stiftung v. Renishaw PLC, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements to derive an integrated device, as claimed by the Applicant.

When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the "absence of such a suggestion to combine is dispositive in an obviousness determination").

Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be “clear and particular.” Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617.

If there was no motivation or suggestion to combine selective teachings from multiple prior art references, one of ordinary skill in the art would not have viewed the present invention as obvious. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); Gambro Lundia AB, 110 F.3d at 1579, 42 USPQ2d at 1383 (“The absence of such a suggestion to combine is dispositive in an obviousness determination.”).

Significantly, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. Winner Int'l Royalty Corp. v. Wang, No 98-1553 (Fed. Cir. January 27, 2000).

For at least the additional reason that the Office Action failed to identify proper motivations or suggestions for combining the various references to properly support the rejections under 35 U.S.C. § 103, those rejections should be withdrawn.

CONCLUSION

For at least the reasons described above, all claims are in condition for allowance.

Should Examiner feel that a telephone discussion would expedite the examination of this application, the Examiner is invited to contact the undersigned attorney.

No fee is believed to be due in connection with this Amendment and Response to Office Action. If, however, any fee is believed to be due, you are hereby authorized to charge any such fee to deposit account No. 20-0778.

Respectfully submitted,

By: 

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